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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,393	04/12/2004	Solomon Dabah	V12-008	2894

7590 05/11/2006
R. Neil Sudol
714 Colorado Avenue
Bridgeport, CT 06605-1601

EXAMINER

MOHANDESI, JILA M

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 05/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/822,393	DABAH, SOLOMON	
	Examiner	Art Unit	
	Jila M. Mohandesi	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Bazzle et al. (4,130,950). Bazzle et al. '950 discloses all the limitations of the claim including the following: a shoe having an upper; a midsole (the layer on the bottom of the upper, where the spikes 11 protrude from) coupled to said upper; an outsole (spikes 11) fastened to said midsole; and a spinner (disc 23) which is the at least operatively connected to the upper (by magnet 14) and above the bottom (see Figure 1); the at least one disc being rotatable with respect to the shoe (the disc can be placed on the magnet and rotated).

3. Claims 1-2 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Kim (4,771,556). Kim '556 discloses all the limitations of the claim including the following: an upper, a midsole (layer above the outsole not numbered) coupled to said upper; and outsole (bottom of sole that contacts the ground) fastened to said midsole; and a spinner (disc 3); the at least one disc being operatively connected to the upper (see Figures); the at least one disc (3) being rotatable with respect to the shoe (disc can be rotated when placed within the shoe). See Figures 3 and 4 embodiments.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lennihan, Jr. (5,875,568) in view of Misevich et al. (4,854,057). Lennihan '568 discloses all the limitations of the claim including the following: a shoe having an upper (14); an outsole (12) fastened to said upper; and a spinner (shock absorbing insert 20) which is at least operatively connected to the sole (see Figure 1); the at least one spinner being rotatable with respect to the shoe. The spinner having a hub (core 22) and a plurality of arms or spokes (radial ribs 25) radiating from said hub. Lennihan '568 does not appear to teach the shoe comprising a midsole coupled to the upper. Misevich '057 discloses that it is desirable to have a midsole fastened to an outsole and upper in a shoe to provide added comfort to the wearer. Therefore, it would have been obvious to one of

ordinary skill in the art at the time the invention was made to provide a midsole to the shoe of Lennihan '568 as taught by Misevich '057 for added comfort to the wearer.

With respect to the location of the spinner on the shoe, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the location of the spinner on the shoe of Lennihan '568 since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

With respect to claims 5 and 12, whether the connection means is a friction fit or pin projecting or any other art recognized equivalent is an obvious matter of choice, such as cost and ease of manufacturing.

7. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Winford et al. (Pub. No. US 2004/0159022) in view of Misevich et al. (4,854,057). Winford discloses all the limitations of the claim including the following: a shoe having an upper (14); an outsole (12) fastened to said upper; and a spinner (rotating discs 50a, 50b and 50c) which is at least operatively connected to the sole (see Figure 1); at least one spinner being rotatable with respect to the shoe. Winford does not appear to teach the shoe comprising a midsole coupled to the upper. Misevich '057 discloses that it is desirable to have a midsole fastened to an outsole in a shoe to provide added comfort to the wearer. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a midsole to the shoe of Winford as taught by Misevich '057 for added comfort to the wearer.

With respect to the location of the spinner on the shoe, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the location of the spinner on the shoe of Winford since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

With respect to claims 3, 6 and 10, Winford discloses that the rotating discs have illustrated thereon a design of a hubcap or other spoke arrangements to enhance the illusion of rotating wheels. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the discs in the shape of a hub with spokes to further enhance the illusion of the rotating wheels.

Conclusion

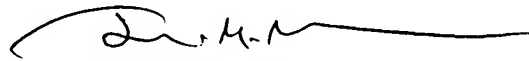
8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shown are shoe analogous to applicant's instant invention.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M. Mohandesi whose telephone number is (571) 272-4558. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3728

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jila M Mohandesi
Primary Examiner
Art Unit 3728

JMM
May 10, 2006